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ALBERT BORDAS, P.A.
5975 SUNSET DRIVE
SUITE 607
MIAMI, FL 33143

EXAMINER	
PRATT, HELEN F	
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PATENT@BORDASIPLAW.COM
INFO@BORDASIPLAW.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUILLERMO SILVA

Appeal 2007-3956
Application 10/765,193
Technology Center 1700

Decided: January 9, 2008

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

1Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1 and 7. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

Claims 1 and 7 read as follows:

1. A rich creamy coconut mixture consisting of:

A) water;

B) a contained and preserved liquid base developed from mixing water, sugar and a coconut cream powder derivative of natural coconut that is processed from natural coconut milk through a spray drying process, said spray drying process is a unit operation where a pumpable said coconut milk liquid feed is finely dispersed or atomized to form droplets that are sprayed into a heated air chamber to facilitate dehydration of said droplets, thus forming powder particles, said powder particles are conveyed to a cyclone where said coconut cream powder is collected;

C) sugar;

D) ice; and

E) contained in a first container and preserved young coconut meat originating from said natural coconut at its immature stage to resemble texture, consistency, taste, and appearance of mixing natural coconut liquid endosperm with jelly-like meat of an immature said natural coconut recently picked from a coconut palm tree, said coconut cream powder derivative comprises said natural coconut and a starch hydrolysis product, said starch hydrolysis product is maltodextrin, said young coconut meat contains mainly water and said jelly-like meat which are collected, bleached and contained in a second container with preservatives.

7. The rich creamy coconut mixture set forth in claim 1, further comprising vanilla extract.

The Examiner maintains a rejection of claims 1 and 7 under 35 U.S.C. § 103(a) as unpatentable over Leaflet No.8[1] in view of Tayag (PH 26114 A

[1] South Pacific Comm'n, Leaflet No. 8 – 1983 – Coconut, "Green coconut drink" (1983).

published Feb. 24, 1992) and Beyerinck (US 6,763,607 B2 issued Jul. 20, 2004 to Beyerinck et al.) (Ans. 2; Supp. Ans. 3).[2]

Appellant contends that none of the applied references alone or in combination teach how to produce their invention (Br. 20-24; Mar. 9, 2007 Reply Br. 1-4; Jun. 4, 2007 Reply Br. 1-4).

The issue presented for review by Appellant and the Examiner is: Does a preponderance of the evidence support the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at the time of the invention to create a rich creamy coconut mixture as claimed?

We are unable to answer the above question. This is because there are ambiguities and inconsistencies in the claims that render the claims indefinite. Review of the rejection under 35 U.S.C. § 103(a) would require considerable speculation as to the scope of the claims. Such speculation would not be appropriate. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) ("[W]e do not think a rejection under 35 U.S.C. § 103 should be based on such speculations and assumptions."). We, therefore, procedurally reverse the 35 U.S.C. § 103(a) rejection. We emphasize that this is a technical reversal of the rejection under 35 U.S.C. § 103(a), and not a reversal based upon the merits of the rejection.

We make the following new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b):

[2] The Examiner had made a rejection under 35 U.S.C. § 112, ¶ 2 in the Final Office Action, but does not reproduce that rejection in the Answers. We treat that rejection as having been withdrawn by the Examiner in response to the entered After-Final Amendment filed July 25, 2006 (*see* Advisory Action).

Claims 1 and 7 are rejected under 35 U.S.C. § 112, ¶ 2 as failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Initially, we note that our basis for this rejection is different from the basis previously advanced by the Examiner.

As a first matter, the preamble of claim 1 is inconsistent with the body of the claim. According to the preamble, what is being claimed is "[a] rich creamy coconut mixture." However, the body of the claim recites that this "mixture" consists of, among other things, "a contained … liquid base," something "contained in a first container," and a young coconut meat "contained in a second container." On the one hand, the preamble seems to be directed to the end product mixture of all the listed ingredients. On the other hand, the body of the claim limits some of the ingredients to products contained within containers. Products in containers are not part of a mixture until the containers are opened and the contents mixed with the other ingredients. A claim must be directed to something with all of its parts in existence at the same time. The claim cannot be directed to both a "mixture" of ingredients (the end product existing after mixing) and the separately packaged ingredients existing before mixing. The scope of the claim is unclear.

As a second matter, claim 1 uses the transitional phrase "consisting of." This phrase closes the claim and limits the "mixture" to only those ingredients that are listed in the body of the claim. *See Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331 (Fed. Cir. 2004) ("'[c]onsisting of' is a term of patent convention meaning that the claimed invention contains only what is expressly set forth in the claim ... [however] it does not limit aspects unrelated to the invention"); *In re Gray*, 53 F.2d 520, 521 (CCPA 1931) (the use of the claim term "consists" is limited to the claim's enumerated alloy metals without other elements). However, some of the ingredients are further defined in a way at odds with the "consisting of" transitional phrase. Namely, part E) requires "said coconut cream powder derivative *comprises* said natural coconut and a starch hydrolysis product" and "said young coconut meat contains *mainly* water and said jelly-like meat ... in a second container with preservatives." The term "comprises" allows the claim to be open to other ingredients in addition to those listed. *CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360-61 (Fed. Cir. 2007). The term "mainly" also opens the claim to other ingredients. The claim is internally inconsistent and its scope unclear.

Moreover, claim 7 which is dependent on claim 1, is inconsistent with claim 1 because it attempts to add another ingredient to a "mixture" closed to the addition of ingredients. Again, the transitional phrase "consisting of" in claim 1 closes that claim to additional ingredients: claim 7 cannot add another ingredient to the closed mixture of claim 1. Moreover, claim 7 uses the transitional phrase "further comprising," a transitional phrase opening the claim to even more ingredients. Again, the language of the claims is inconsistent and its scope unclear.

As a third matter, part E) opens with the recitation "contained in a first container," but does not state what is "contained" in that first container. Part E) proceeds to recite "and preserved young coconut meat" which seems to indicate that it is the young coconut meat which is to be placed in the first container, but at the end of claim 1, part E) recites that the young coconut meat is "contained in a second container." This puts in question what is to be contained in the first container.

For the above reasons, we determine that the claims do not reasonably apprise one of ordinary skill in the art of the scope of the invention as required by 35 U.S.C. § 112, ¶ 2.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED and NEW GROUND OF REJECTION

PL initials:

Appeal 2007-3956
Application 10/765,193

sld

ALBERT BORDAS, P.A.
5975 SUNSET DRIVE
SUITE 607
MIAMI, FL 33143